

REMARKS

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow claims 11-15, 17-18 and 27-38, the only claims pending and currently under examination in this application.

Formal Matters

Claims 11-15, 17-18 and 27-38 are pending after entry of the amendments set forth herein.

Claims 11-15, 17-18, and 27-34 were examined. Claims 11-18 and 27-34 were rejected. No claims were allowed.

Claims 16 and 19-22 have been cancelled.

Claims 11-15, 17-18, 27, and 31 have been amended. Support for the amendments can be found in the claims as originally filed and throughout the specification at, for example: original claim 1, and page 6, lines 11-25.

New Claims 35-38 have been added. Support for new the new claims can be found in the claims as originally filed and in the specification at, for example, original claims 1, 13-18 and page 21, line 21 through page 22, line 3.

As the above amendments introduce no new matter to the application, their entry is respectfully requested.

Rejection Under 35 U.S.C. § 101

Claim 11-12, 16-17, 27-29 and 31-33 have been rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. As suggested in the Office Action, the claims have been amended to recite "non-human". In view of the amendment to the claims, this rejection may be withdrawn.

Rejection Under 35 U.S.C. § 112, First Paragraph – Enablement

Claims 11-18 and 27-34 have been rejected under 35 U.S.C. § 112, first paragraph on the basis that the specification allegedly does not enable any person skilled in the art to which it pertains, or which it is most closely connected, to make and use the claimed invention commensurate in scope with the claims. The Office Action does acknowledge that enablement is present for making a transgenic mouse using a P-element derived vector. The Applicant respectfully traverses this rejection as it is applied to the pending claims.

As the Applicants understand it, the Office Action asserts that the specification does not provide enablement for making any transgenic animal using any transposon derived insertion sequence commensurate with the scope of the claims.

With respect to use of any transposon derived insertion sequence, in the spirit of expediting prosecution and without conceding as to the correctness of the rejection, the claims have been amended to recite “a P-element derived vector”.

The law regarding enablement of inventions is clear: “[t]he test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosure in the patent coupled with information known in the art without undue experimentation.”¹

Disclosure of the Present Application

The Applicants maintain that the present application provides sufficient disclosure to enable the invention to the full scope of the pending claims. The present specification clearly details the preparation and production of such transgenic animals. Beginning on page 10, the specification provides a detailed disclosure of how to generate such animals using the transposase recognized insertion sequence vectors and a variety of well known nucleic acid delivery techniques, as well as references describing such techniques in greater detail. Moreover, the specification further

1. *United States v. Teletronics, Inc.*, 8 USPQ 2d 1217, 1233 (Fed. Cir. 1988), *cert. denied*, 490 U.S. 1046 (1989). See also *Genentech, Inc. v. Novo Nordisk*, 42 USPQ 2d 1001 (Fed. Cir. 1997), *cert. denied*, 522 U.S. 963 (1997); *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ 2d 1001 (Fed. Cir. 1991).

provides working examples showing use of such vectors in generating transgenic rodents. Accordingly, the Applicants maintain that the specification fully demonstrates that such non-human and non-drosophilidae transgenic animals according to the pending claims without practicing undue experimentation.

In addition to standard methods of generating transgenic animals, such as DNA microinjection, at the time the present application was filed methods of overcoming hurdles faced in generating transgenic animals using standard techniques were also well known. For instance methods of using inducible gene expression systems, such as the tetracycline regulateable system for controlling gene function in transgenic animals (see Exhibit A: Saez et al., *Curr. Opin. Biotech.*, 1997, 8(5):608-616), and other methods of improving strategies for generating transgenic animals (see Exhibit B: Jacenko et al., *Methods Mol. Biol.*, 1997, 62:399-424; Exhibit C: Cameron et al., *Mol. Biotech.*, 1997, 7(3):253-265) were well documented.

Accordingly, the Applicants maintain that once transgenesis is demonstrated in one species using at least two different transposase recognized insertion sequence vectors, as detailed in the present specification and described above, it is reasonable to conclude that the methods could be extrapolated to other mammalian animals in a similar manner without undue experimentation. Therefore, once the Applicants demonstrated the possibility of the described method with one species, it is reasonable to conclude that such methods can be used to generate transgenic animals of different species using a vector that comprises a transposase recognized insertion sequence and an exogenous nucleic acid with a reasonable amount of experimentation.

Therefore, the Applicants assert that the methods disclosed in the present specification in conjunction with the knowledge available in the art at the time the present application was filed, would enable one of ordinary skill in the art to practice the invention to the full scope of the claims.

In re Wands Factors

In addition to the above, application of the *In re Wands* test to the facts of the present application leads to the conclusion that the presently pending claims are fully enabled, as demonstrated below.

Under *In re Wands*, a determination of enablement requires consideration of eight factors, including: (a) the quantity of experimentation necessary; (b) the amount of direction or guidance presented; (c) the presence or absence of working examples; (d) the nature of the invention; (e) the state of the prior art; (f) the relative skill of those in the art; (g) the predictability or unpredictability of the art; and (h) the breadth of the claims.² Accordingly, under *In re Wands*, a determination of enablement is based on the combination of the factors, taken as a whole, not based solely on a single factor.

In the present application, the Applicant further maintains that the specification, coupled with the information known in the art, would enable one skilled in the art to use the invention without undue experimentation. However, in order to provide structure to the Applicant's response, each of the relevant enablement factors is further discussed in detail below.

(a) the unpredictability in the art and the quantity of experimentation necessary

The Applicant notes that the courts have clearly taught that the fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. For example, see MPEP § 2164.01.³ Accordingly, the Applicant's citation of *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, in the previous response was to emphasize that where the "experiments are empirical in nature," as in

2. *Ex Parte Forman.*, 230 USPQ 546, 547 (Bd.Pat.App & Interf. 1986); and, *In re Wands*, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

3. See also *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'd sub nom.*, *Massachusetts Institute of Technology v. A.B. Fortia*, 227 USPQ 428 (Fed. Cir. 1985).

the case of the present application, the court found that no undue experimentation is required.⁴

In citing the research publications the Applicant have sought to establish that the field of generating transgenic mammalian animals is not as unpredictable as stated by Examiner. The publications cited above represent only a small fraction of the total number of publications demonstrating the successful generation of transgenic non-human mammalian animals. Furthermore, the cited research publications establish that in order to make and use the transgenic animal models according to the full scope of the claims in the present application, undue and excessive experimentation would not be required.

The methods disclosed in the cited references used to generate the transgenic non-human mammalian animals were not exactly the same as the method disclosed in the present application. However, the publications have been cited to establish that by reporting the successful generation of non-human mammalian transgenic animal models, the cited publications have substantiated the Applicant's position that the field is not as unpredictable as asserted by the Examiner.

Therefore, since the field is not unpredictable, the fact that the experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation, especially if the experimentation is empirical in nature. Accordingly, the Applicant maintains that the "how to make" and "how to use" requirements of 35 U.S.C. §112, first paragraph, have been fulfilled.

As such, the Applicant maintains that the art is replete with successful attempts at generating non-human mammalian transgenic animals. Therefore, the field cannot be as unpredictable and requiring of undue and excessive experimentation as the Examiner stresses. As such, the Applicant respectfully submits that the specification coupled with the information available in the art, at the time the application was filed, would enable one skilled in the art to use the invention without undue experimentation.

⁴ *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81 (Fed. Cir. 1986).

(b) the breadth of the claims and the amount of direction or guidance presented

The Applicants argue that the requirement for guidance in the specification shall be taken in conjunction with the guidance available in the art. As noted above, other methods of generating non-human mammalian transgenic animals are disclosed in the art. One skilled in the art of methods involving manipulating DNA and performing cell-based assays would be able to combine the guidance in the disclosure and the guidance available in the art to practice the claimed invention.

Accordingly, the Applicant maintains that the guidance provided in the specification and highlighted in the previous response, when taken in conjunction with the other enablement factors under *In re Wands*, provides the requisite amount of direction and guidance for a person skilled in the art to make and practice the invention to the full scope of the pending claims.

(c) the presence or absence of working examples

The Applicant respectfully notes that under the *In re Wands* factors for determining compliance with the enablement requirement under Title 35 U.S.C. §112, first paragraph, the presence or absence of working examples is but a single factor to be taken in consideration with the other factors. As such, under *In re Wands*, the presence or absence of working examples is weighed against the other factors, such as the availability in the art of general guidelines relevant to the claimed invention and guidance provided in the specification.

Moreover, the Applicants cite *In re Robbins* and *In re Borkowski* to emphasize that compliance with the enablement requirement under Title 35 U.S.C. §112, first paragraph does not require or mandate that a specific example be disclosed.⁵ Accordingly, the specification need not contain a working example if the invention is otherwise disclosed in such a manner that one skilled in the art would be able to practice the invention without undue experimentation.⁶

⁵ *In re Robins* 166 U.S.P.Q. 552 (CCPA 1970); *In re Borkowski*, 164 U.S.P.Q. 642 (CCPA 1970).

⁶ *In re Borkowski*, 164 USPQ at 642.

However, as the Examiner notes in the Office Action, the present application does contains at least two working examples demonstrating (1) the creation of transgenic mice using the P-element derived vectors (pages 18-20), and (2) the creation of transgenic mice using the Sleeping Beauty derived vectors (pages 21-22).

Therefore, the working examples, taken in conjunction with the general guidelines regarding creation of transgenic non-human and non-drosophilidae animals available in the art and the guidelines disclosed in the specification, provides one skilled in the art adequate enablement to practice the claimed invention.

Accordingly, the Applicant maintains that the present application does enable a person skilled in the art, through the specification as well as the working example, sufficient enablement to apply the teachings in the specification in conjunction with the relevant art to make and use the claimed invention.

(d) the relative skill of those in the art

The Applicants maintain that the present invention involves methods of manipulating DNA and performing cell-based assays. As such, the Applicant notes that the skill level of an artisan, such as a laboratory technician or scientist with experience in molecular biology or the equivalent of a doctoral degree in molecular biology techniques, in using such methods is high.

In sum, the Applicant maintains that the enablement requirement has been met because a) the amount of experimentation required to create a non-human mammalian transgenic animal would not be undue and excessive b) working examples have been provided, c) guidance is given on how to generate and use such animal models, and d) one of skill in the art would be able to perform the experiments as a matter of routine. The specification, therefore, provides sufficient enablement such that one of ordinary skill in the art would be able to practice the invention without undue experimentation.

As such, for at least the reasons described above, claims 11-18 and 27-34 are adequately enabled by the specification. Accordingly, the Applicants respectfully

request that the rejection of claims 11-18 and 27-34 under 35 U.S.C. §112, first paragraph be withdrawn.

Rejection Under 35 U.S.C. § 112

Claims 12 and 16-18 have been rejected under 35 U.S.C. §112 for failing to provide proper antecedent bases for claim terms. Claims 12 and 16-18 have been amended to address the antecedent basis. Therefore, this rejection may be withdrawn.

Rejection Under 35 U.S.C. § 102

Dupuy et al.

Claims 11-18 have been rejected under 35 U.S.C. § 102(a) for allegedly being anticipated by Dupuy et al. (Genesis 30:82-88 (2001)). In view of the following remarks, this rejection may be withdrawn.

In the spirit of expediting prosecution and without conceding as to the correctness of the rejection, the claims have been amended to recite "**a P-element derived vector**".

It is well established that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987), cert. denied, 481 U.S. 1052 (1987). See also, Scripps Clinic and Research Foundation v. Genentech, Inc., 18 USPQ 2d 1001 (Fed. Cir. 1991).

The Examiner has not shown where Dupuy et al. teach a method of inserting an exogenous nucleic acid using a **P-element derived vector** into the genome an animal, the cited reference fails to disclose each and every element found in the claims of the present invention. Therefore, the Applicants respectfully request that this rejection be withdrawn.

Raz et al.

Claims 11-18 have been rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by Raz et al. (Current Biology 8:82-88 (1997)). In view of the amendments to the claims and the following remarks, this rejection may be withdrawn.

As noted above, the present claims have been amended to recite "**a P-element derived vector**".

The Examiner has not shown where Raz et al. teach a method of inserting an exogenous nucleic acid using a **P-element derived vector** into the genome an animal, the cited reference fails to disclose each and every element found in the claims of the present invention. Therefore, the Applicants respectfully request that this rejection be withdrawn.

Rejection Under 35 U.S.C. § 103

Claims 27-34 have been rejected under 35 U.S.C. § 103(a), for allegedly being rendered obvious by Clough et al. (MCB 5(4):898-901 (1985)) in view of Rio et al. (J. Mol. Biol. 200:411-415 (1998), or Cell 44:21-32 (1986), or TIG 7:282-287 (1991)). In view of the following remarks, this rejection may be withdrawn.

The present claims are directed to **a non-human and non-Drosophilidae animal or cells derived from the animal** that has P-element transposase recognized insertion sequences integrated into the genome.

The law is clear that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 USPQ 375 (Fed. Cir. 1986). Finally, **the prior art reference, or references when**

combined, must teach or suggest all the claim limitations. *In re Royka*, 180 USPQ 580 (CCPA 1974).

The combined teaching of the cited references fails to teach or suggest a non-human and non-Drosophilidae **animal or cells derived from the animal** that have a P-element transposase recognized insertion sequences integrated into the genome. In fact, the teaching of all the cited references is directed to cells in culture or drosophila. The Examiner has not shown where cited references teach a non-human and non-Drosophilidae **animal or cells derived from the animal**. None of the cited references, alone or in any combination, provide for insertion of a transposase sequence into the genome of an animal.

Accordingly, these references fail to teach or suggest the claimed invention and this rejection may be withdrawn.

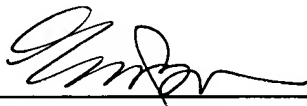
Conclusion

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number TOSK-007CIPCON

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: May 9, 2006

By: 
Edward J. Baba
Registration No. 52,581

Date: May 4, 2006

By: 
Bret E. Field
Registration No. 37,620

Enclosure:

- Exhibit A: Saez et al., *Curr. Opin. Biotech.*, 1997, 8(5):608-616.
- Exhibit B: Jacenko et al., *Methods Mol. Biol.*, 1997, 62:399-424.
- Exhibit C: Cameron et al., *Mol. Biotech.*, 1997, 7(3):253-265.

BOZICEVIC, FIELD & FRANCIS LLP
1900 University Avenue, Suite 200
East Palo Alto, CA 94303
Telephone: (650) 327-3400
Facsimile: (650) 327-3231

F:\DOCUMENT\Tosk\007cipcon\Response to Office Action 12-5-05.doc